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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,785	11/30/2000	Rich Robinson	P209/1938P	2704
49278	7590	03/15/2006	EXAMINER VAUGHN, GREGORY J	
IPAC 111 Corning Road Suite 220 Cary, NC 27511			ART UNIT 2178	PAPER NUMBER

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/728,785

Applicant(s)

ROBINSON ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-32.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.



**STEPHEN HONG
SUPERVISORY PATENT EXAMINER**

Continuation of 5. Applicant's reply has overcome the following rejection(s): Applicant's amendment to claims 1 and 10 has overcome the rejection made under 35 USC 112 second paragraph as recited on page 4 of the office action mailed 12/23/2005, therefore the rejection of claims 1-15 made under 35 USC 112 second paragraph as recited in the office action mailed 12/23/2005 is withdrawn. Applicant's remarks have overcome the rejection of claims 1-32 made under 35 USC 112 first paragraph, therefore the rejection of claims 1-32 made under 35 USC 112 first paragraph as recited in the office action mailed 12/23/2005 is withdrawn.

Continuation of 7. Claims 1, 7-10, 16 and 22-24 remain rejected under 35 USC 102. Claims 2-6, 11-15 and 17-21 remain rejected under 35 USC 103. All rejections are as described in the office action mailed 12/23/2006.

Continuation of 11. does NOT place the application in condition for allowance because: The cited prior art of record discloses the claimed invention. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a custom tag having a second pre-defined function" (page 16, last paragraph) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant also argues "Pavley does not disclose storing a definition that causes an attribute, such as the archiving attribute, to have a second function, as claim 1 requires" (page 17, last paragraph). The examiner respectfully disagrees. Pavley discloses the use of rule sets wherein the multiple rule sets determine different (i.e. first, second, third etc.) functionality of the image tags. Pavley recites: "With a common operating environment, an image file 1104 that includes file attribute designations in accordance with the present invention is successfully and automatically handled within the photosystem environment based on established rule sets" (column 5, lines 56-60) (compare "second function" to "rule sets").

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the respective functions associated with the file attributes are altered when the file attributes are associated with an image file" (page 16, last paragraph - emphasis added) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that "Pavley also fails to disclose storing a key ID and a definition for altering a first pre-defined function of an image tag" (page 18, second paragraph) and "Pavley's header 805 does not define the altering of a first predefined function of an image tag" (page 18, third paragraph). The examiner respectfully disagrees. Pavley discloses a header 805 that "preferably includes information that identifies and describes the various contents of the image file". Note that the header includes at least two components, information that identifies (the key ID) and information that describes (the function). As described previously, Pavley discloses the use of more than one rule set, hence more than one definition/function for a given tag..